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10/591,392	09/01/2006	Giovanni Nencioni	6768/PCT	9572
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EXAMINER				
DUCHENEAUX, FRANK D				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/591,392

Applicant(s)

NENCIONI ET AL.

Examiner

FRANK D. DUCHENEAUX

Art Unit

1788

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-65, 68-75 and 77-126 is/are pending in the application.
- 4a) Of the above claim(s) 86-124 and 126 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63-65, 68-75, 77-85 and 125 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Examiner's Note

1. The Examiner acknowledges the cancellation of claims 66-7 and 76 in the amendments filed 5/19/2011.

In light of the new grounds of rejection as set forth below, the following action is made non-final.

Response to Amendment

2. Applicant's arguments, see the claim amendments and page 20 of the remarks filed 5/19/2011, with respect to the rejection of **claims 63-85** under 35 U.S.C. 112, 1st paragraph as set forth in paragraph 6 of the action mailed 1/19/2011, have been fully considered and are persuasive. The rejection of claims 63-85 has been withdrawn.
3. Applicant's arguments, see the claim amendments and pages 20-21 of the remarks filed 5/19/2011, with respect to the rejection of claim 125 under 35 U.S.C. 112, 1st paragraph as set forth in paragraph 7 of the action mailed 1/19/2011, have been fully considered and are persuasive. The rejection of claim 125 has been withdrawn.
4. Applicant's arguments, see the claim amendments and pages 21-22 of the remarks filed 5/19/2011, with respect to the rejection of **claims 63-85** under 35 U.S.C. 112, 2nd paragraph as

set forth in paragraph 9 of the action mailed 1/19/2011, have been fully considered and are persuasive. The rejection of claims 63-85 has been withdrawn.

5. Applicant's arguments, see the claim amendments and page 22 of the remarks filed 5/19/2011, with respect to the rejection of claim 125 under 35 U.S.C. 112, 2nd paragraph as set forth in paragraph 10 of the action mailed 1/19/2011, have been fully considered and are persuasive. The rejection of claim 125 has been withdrawn.

Rejections

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

7. **Claims 63-65, 68-75 and 82** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppel et al. (US 6287676 B1).

Regarding claims 63-65, 68-73 and 82, Ruppel teaches compound sheets made of absorbent paper (multi-ply web material) (abstract) comprising sheets (1) and (2) (1st and 2nd ply) having deep embossing patterns (3) (1st and 2nd pattern...protuberance projecting inward) having a height of 0.5 to 2.5 mm, a density of 3 to 19 bosses/cm², which overlaps that presently claimed, and a cross section of an oval, circle etc. (column 2, lines 42-52), which said density and emboss height provides improved touch, flexibility and appearance (column 1, lines 38-45).

As set forth in MPEP 2144.05, in the case where the claimed range “overlap or lie inside ranges disclosed by the prior art”, a *prima facie* case of obviousness exists, *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Ruppel also teaches that both sheets comprise a second embossing pattern (4) of smaller bosses (1st and 2nd ply background pattern) having a height between 0.1 to 0.30 mm (less than the height of the 1st and 2nd decorative pattern), and a density larger than that of the first pattern in a ratio of at least 2 (density greater than 8 protuberances/cm²) (column 2, lines 53-64). The examiner notes that the embossments of the second embossment pattern as disclosed by Ruppel, by virtue of its existence, would necessarily have a geometrical form as presently claimed.

Ruppel continues to teach that a third sheet (third ply) can be sandwiched (lamination of current claim 82) between (interposed) the two embossed sheets without exceeding the scope of the invention (column 2, lines 65-67), while figure 2 (see also column 3, lines 1-3) of the disclosed invention demonstrates that the embossments (3) of sheet (1) are arranged in an intercalating manner with the embossments (3) of sheet (2), and that the two sheets are linked via glue (first adhesive) on the top of the bosses of the first pattern (corresponding protuberances' areas of the 1st decorative elements) of one of the sheets (column 3, lines 3-5).

The Examiner notes that Ruppel clearly teaches that a third sheet sandwiched between the two outer sheets is within the scope of the present invention. Thus, one of ordinary skill in the art would have been apprised to apply glue to the tips of both outer sheets (second adhesive applied to second ply) in order to adhere said outer sheets to the said sandwiched third, inner sheet (1st and 2nd plies adhesively bonded to third ply).

The Examiner also notes that the embossments (3) of sheets (1) and (2) are at least different from one another in that they are projecting in opposite directions to one another (see figure 2), and/or that an oval cross section and a circular cross section for the embossments of sheets (1) and (2) (see column 2, lines 42-52), respectively, would also teach first decorative elements and second decorative elements that are different from each other as presently claimed. It is noteworthy (see *In re Seid* below) that a choice between said cross sections would be obvious to the skilled artisan.

Claim limitations relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art (*In re Seid* 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

The examiner also notes that the intercalated manner of the embossments (3) of the reference would necessarily teach that the areas of a second ply corresponding to areas of a first ply having an embossment would be devoid of a protuberance as presently claimed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to select a density of embossments (3) identical to that presently claimed, which said embossments (3) of the two outer sheets (1) and (2) having different cross sectional shapes, towards an absorbent paper of compounded sheets providing improved touch, flexibility and appearance as in the present invention.

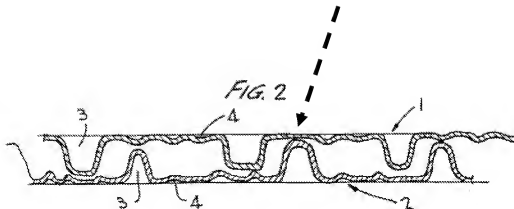
Although Ruppel does not disclose a first adhesive applied to a third ply (current claim 64), which is made to seep at least partly through said third ply to adhere said third ply to said

second ply (current claim 65), it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

As set forth above, Ruppel teaches a first and second ply bonded to a third ply in areas of the bosses of the first pattern via the application of glue to said bosses, which is identical to the presently claimed adhesively bonded, three-ply construct, regardless of whether the said glue is applied to the third ply or whether said glue is first applied to one of said outer sheets followed by seepage of said glue through the third, interposed sheet.

Therefore, absent evidence of criticality regarding the presently claimed process and given that Ruppel meets the requirements of the claimed composition, Ruppel clearly meets the requirements of the present claims.

Regarding claims 74-75, the examiner notes that following figure, taken from the figure 2 of the Ruppel reference,



wherein it is noted that the emboldened, hashed arrow (provided by the examiner) points to a portion of the top sheet (1) that is flat in the area where the embossment (3) of the lower sheet (2) is located.

While the Ruppel reference does not disclose that any or some of the second embossing pattern of the top sheet (1), or any or some of the embossments of the first embossing pattern of either sheets (1) or (2), is flattened by an embossment (3), it is the examiner's position that the configuration of figure 2 provides a flattened portion of the upper sheet corresponding to embossment (3) in a manner identical to that presently claimed, and absent evidence of criticality regarding the presently claimed process and given that Ruppel meets the requirements of the claimed invention, Ruppel clearly meets the requirements of the present claims.

8. **Claims 77-78** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppel et al. (US 6287676 B1) in view of Hollenberg et al (US Patent 6221211 B1).

Regarding claims 77-78, Ruppel teaches compound sheets made of absorbent paper as in the rejection of claim 63 above. Ruppel is silent to a colored third ply and a third ply with a printed pattern.

However, Hollenberg teaches multi-ply tissues having internal indicia (title) comprising a multi-ply tissue comprising two outer plies and one center ply, said center ply containing colored or patterned indicia which is visible through both outer plies (column 1, lines 49-52) and also suitable are solidly colored center plies (column 2, lines 19-21).

Hollenberg continues to teach facial and bath tissues provided with a distinctive visual cue or indicator accomplished by printing, dyeing or otherwise coloring an internal surface of one or more plies of a multi-ply tissue, which indicates that such tissues contain unique ingredients or properties (column 1, lines 20-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Ruppel and Hollenberg in order to further provide decorative features to an absorbent paper as in the present invention.

9. **Claims 79-81** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppel et al. (US 6287676 B1) in view of Roussel et al (US 6599614 B1).

Regarding claims 79-81, Ruppel teaches compound sheets made of absorbent paper as in the rejection of claim 63 above. Ruppel is silent to a first ply, a second ply and a third ply are

composed of two or more layers, which said two or more layers are joined to one another via mechanical ply-bonding.

However, Roussel teaches a three ply absorbent paper product (title) including first and second external embossed plies and central or third smooth unembossed ply (column 4, lines 48-51), and that each ply includes one or more layers forming a laminate (two or more layers) (column 5, lines 12-13).

Although Ruppel and Roussel do not disclose mechanical ply-bonding as recited in claim 80, it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed process and given that Ruppel and Roussel meet the requirements of the claimed structure, Ruppel and Roussel clearly meets the requirements of the present claims.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Ruppel and Roussel references to provide a three ply absorbent paper, wherein at least a central third ply is formed of at least two layers, towards an absorbent paper having, *inter alia*, increased absorbency and strength as in the present invention.

10. **Claim 83** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppel et al. (US 6287676 B1) in view of Biagiotti (US Patent 6755928 B1).

Regarding claim 83, Ruppel teaches compound sheets made of absorbent paper as in the rejection of claim 63 and 66 above. Ruppel is silent to a first and second adhesive that chromatically different from each other.

However, Biagiotti teaches a method and device for producing an embossed web material and product made (title) wherein the method includes producing a soft product and increasing the decorative effect of the embossing by combining it with the use of colored adhesives (column 2, lines 22-26) so that ornamental motifs stand out from the background of the web material.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Ruppel and Biagiotti references to provide a plurality of colored adhesives towards a more decorative absorbent paper with varied chromatic possibilities as in the present invention.

11. **Claims 84-85** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppel et al. (US 6287676 B1) in view of Roussel et al (US 6599614 B1).

Regarding claims 84-85, Ruppel teaches compound sheets made of absorbent paper as in the rejection of claim 63 above. Ruppel is silent to a web material wound in a manner to form a roll, said web material on a roll having a first pattern of the first outer surface composed of decorative elements positioned symmetrically to a straight line parallel to a longitudinal axis of the roll.

However, Roussel teaches a web roll form (column 5, lines 54-59) as well as having external plies with patterns and different pitches in the direction of advance and in the transverse direction (symmetric)(column 5, lines 29-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to roll the absorbent paper of Ruppel in a manner identical to that presently claimed, to include embossments symmetric about a longitudinal direction of a roll, as it is ubiquitously known in the art to provide absorbent paper as disclosed in the Ruppel invention in such a manner.

12. **Claim 125** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppel et al. (US 6287676 B1).

Regarding claim 125, Ruppel teaches compound sheets made of absorbent paper (multi-ply web material) (abstract) comprising sheets (1) and (2) (1st and 2nd ply) having deep embossing patterns (3) (1st and 2nd pattern...protuberance projecting inward) having a density of 3 to 19 bosses/cm² and a cross section of an oval, circle etc. (column 2, lines 42-52), which said density and emboss height provides improved touch, flexibility and appearance (column 1, lines 38-45).

As set forth in MPEP 2144.05, in the case where the claimed range “overlap or lie inside ranges disclosed by the prior art”, a *prima facie* case of obviousness exists, *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Ruppel continues to teach that a third sheet (third ply) can be sandwiched between (interposed) the two embossed sheets without exceeding the scope of the invention (column 2, lines 65-67), while figure 2 (see also column 3, lines 1-3) of the disclosed invention demonstrates that the embossments (3) of sheet (1) are arranged in a staggered manner with the embossments (3) of sheet (2), and that the two sheets are linked via glue (first adhesive) on the top of the bosses of the first pattern (corresponding protuberances’ areas of the 1st decorative elements) of one of the sheets (column 3, lines 3-5).

The Examiner notes that Ruppel clearly teaches that a third sheet sandwiched between the two outer sheets is within the scope of the present invention. Thus, one of ordinary skill in the art would have been apprised to apply glue to the tips of both outer sheets (corresponding protuberances’ areas of the 2nd decorative elements) in order to adhere said outer sheets to the said sandwiched third, inner sheet (1st and 2nd plies adhesively bonded to third ply)

The applicants' attention is directed to figure 2 of Ruppel, wherein it is noted that the embossments (3) of sheet (1) and sheet (2) are staggered in an alternating fashion respective to one another.

The examiner notes that the embossments (3) of sheets (1) and (2) are an oval cross section and a circular cross section (see column 2, lines 42-52), respectively, would also teach first decorative elements and second decorative elements that are different in shape from each other as presently claimed. It is noteworthy (see *In re Seid* below) that a choice between said cross sections would be obvious to the skilled artisan.

Claim limitations relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art (*In re Seid* 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

The examiner also notes that the intercalated manner of the embossments (3) of the reference would necessarily teach that the areas of a second ply corresponding to areas of a first ply having an embossment would be devoid of a protuberance as presently claimed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to select a density of embossments (3) identical to that presently claimed, which said embossments (3) of the two outer sheets (1) and (2) having different cross sectional shapes, towards an absorbent paper of compounded sheets providing improved touch, flexibility and appearance as in the present invention.

Response to Arguments

13. Applicant's arguments, see the claim amendments and pages 23-27 of the remarks filed 5/19/2011, with respect to the rejections of **claims 63-76 and 82** over Ruppel et al. under 35 U.S.C. 103(a); **claims 77-78** over Ruppel et al. in view of Hollenberg et al. under 35 U.S.C. 103(a); **claims 79-81** over Ruppel et al. in view of Roussel et al. under 35 U.S.C. 103(a); **claim 83** over Ruppel et al. in view of Biagotti under 35 U.S.C. 103(a); **claims 84-85** over Ruppel et al. in view of Roussel et al. under 35 U.S.C. 103(a); and **claim 125** over Ruppel et al. under 35 U.S.C. 103(a) as set forth respectively in paragraphs 13-18 of the action mailed 1/19/2011, have been fully considered but they are not persuasive.

The Applicants argue that Ruppel does not disclose, nor does Ruppel allow for, first and second glue in different areas on first and second plies to bond the first ply to a third ply with the first glue, and the second ply to the third ply with the second glue as the device of figure 3 of Ruppel applies glue only to one ply and applying pressure on the protuberances on that ply.

The Applicants submit that there is no teaching or suggestion in the reference that a second glue is, or could be, applied on protuberances generated on the second ply by roller 105, nor is there a teaching that third ply is fed between the first ply and the second ply and that pressure is applied on:

- a) protuberances of the first ply to adhere the first ply and the third ply together via the first glue and,
- b) protuberances of the second ply to adhere the second ply and the third ply together by a second glue.

It is the Applicants' contention that Ruppel as whole does not teach, nor fairly suggest, to an artisan of ordinary skill to modify the article of manufacture described in Ruppel, which is produced by the method and machine described by Ruppel to arrive at the invention recited in present claim 63.

With respect to the importation of the limitations of previous claims 66-67 into current claim 63, the Applicants argue against the previous rejections of claims 66-67 over Ruppel as the Applicants assert that Ruppel does not teach using two different glues, one of which is applied on a first ply and the other applied to a second ply, in order to adhere a first ply to a third ply and a second ply to a third ply, respectively.

Rather, the Applicants assert, Ruppel teaches placement of the projections of the first ply in a nested position between the projections of the second ply, and adhering the first ply to a second plies via placement of glue on the projection tips of the first ply, which does not teach using first and second glues between a first ply and third ply and second ply and a third, respectively, and that one of ordinary skill in the art would not be motivated, or find suggestion, to modify the disclosed Ruppel article in a manner leading to the presently claimed web material as set forth in current claim 63.

The Examiner respectfully disagrees with the Applicants' arguments and directs the Applicants' attention to the prior art rejections set forth above, and the citations from Ruppel noted therein, especially to column 2, lines 65-67, wherein it is clearly disclosed that Ruppel provides for a third sheet sandwiched between the two embossed outer ones without exceeding the scope of the invention.

It is noted that “obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant’s motivation”, *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1966).

Also, “nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims.” *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960).

Thus, while Ruppel teaches the methods and machine as cited by the Applicants for a two-sheet configuration as demonstrated in figure 3, Ruppel also discloses the incorporation of a third sheet sandwiched between the two outer sheets, which would have rendered obvious to one of ordinary skill in the art at the time of the present invention to further apply glue to those portions of the sheet not shown as having applied glue in said figure in order to bond the said sheet to the third, interposed sheet as presently claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK D. DUCHENEAUX whose telephone number is (571)270-7053. The examiner can normally be reached on M-Th, 7:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Alicia A. Chevalier can be reached on (571)272-1490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia Chevalier/
Supervisory Patent Examiner, Art Unit 1788

/F. D. D./
Frank D. Ducheneaux
Examiner, Art Unit 1788
7/24/2011